

REMARKS

Claims 14 to 37 are now pending.

Reconsideration is respectfully requested based on the following.

With respect to paragraph three (3) of the Office Action, claims 14 to 37 were again rejected under the first paragraph of 35 U.S.C. § 112 as to the enablement requirement.

It is again respectfully submitted that the presently claimed subject matter of claim 14 is described in such detail in the specification that it is enabled as to one skilled in the art.

In particular, it is respectfully submitted that one skilled in the art in the particular field – image processing – is familiar with and understands the term probability and its calculation, *as used in the specification and in the claimed subject matter*. In particular, one skilled in the art understands that the probability is a measure for the confidence that a specific statement can be made or that a specific event will occur, and that probabilities are often expressed in figures, by numerical values between 0 and 1. This makes it understandable to one skilled in the art, and he can express in mathematical terms what is to be understood by a probability that an image displacement will occur without an additional movement.

From the description in the Substitute Specification, one skilled in the art gathers or understands from the disclosure at page 14, lines 11 through 16, that the probability that the image displacement occurs without additional movement is determined at different positions of an image. This has not been refuted in the Final Office Action.

Still further, from the following sections up to page 15, line 12, one skilled in the art may readily gather or understand the way in which these probabilities are determined. In a first variant, the probabilities are determined based on the special recording situation using a speaker. One skilled in the art gathers or understands here that a priori knowledge is used in the selection and specification of the image regions. In conjunction with the knowledge about probabilities, one skilled in the art gathers from this text passage that one assigns high probabilities that the image displacement occurs without additional movement to image regions that are predominantly filled with image data from the image background, and that one assigns low probabilities to the image regions that are predominantly filled with image data from the image foreground. This also has not been refuted in the Final Office Action.

Also, as an alternative procedure, one skilled in the art gathers or understands from the Substitute Specification at page 15, lines 7 through 12, that one determines the probability using criteria such as edge detection or absence of edge detection. If no edges are

present, he will assign such image regions high probability that the image displacement occurs without the additional movement. From the Substitute Specification at page 1, lines 22 through 31, one skilled in the art gathers or understands the criterion for determining the position and the dimensions of an image region, where selected are image regions in the components of the image that are distinguished by the greatest possible probability that the image displacement occurs without the additional movement. This also has not been refuted in the Final Office Action.

Finally, one skilled in the art gathers or understands from the description and disclosure of the Substitute Specification at page 15, lines 14 through 19, an example for a specific and fixedly specified image region.

In view of the foregoing, it is respectfully submitted that each of the rejected claims is enabled in view of the present application, including the Substitute Specification.

As further regards the enablement rejections, it is respectfully submitted that the assertions and arguments of the Office Actions to date presented do not fully reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, it is axiomatic that the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407))). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the

examiner's analysis must therefore "consider all the evidence related to each of these factors" so that any non-enablement conclusion "must be based on the evidence as a whole." (See M.P.E.P. § 2164.01).

Also, an examiner bears the initial burden of establishing why the "scope of protection provided by a claim is not adequately enabled by the disclosure." (See *id.* (citing *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))).

Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See *id.*).

In contrast to the above, however, it is respectfully submitted that the assertions to date do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as would be understood by a person having ordinary skill in the art in view of the disclosure of the present application, including the specification — and as explained above. In short, the assertions to date are essentially conclusory and still do not adequately address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of *Ex Parte Reese*, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any "evidence or sound scientific reasoning" and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in *Ex parte Reese* was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory

statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." (See id. at 1222 & 1223; italics in original).

As to the assertions as presented, the present application plainly discloses how to use the subject matter of the rejected claims, as explained above more fully above.

It is therefore respectfully requested that the enablement rejections be withdrawn in view of the foregoing as to claim 14 and its dependent claims, and as to the remaining independent claims (and their dependent claims), since these claims are enabled for essentially the same reasons as claim 14, as explained above.

It is therefore respectfully submitted that all of claims 14 to 37 are allowable.

Conclusion

In view of the foregoing, it is believed that the rejections (and any objections) have been obviated, and that claims 14 to 37 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,

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